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09/973,031	10/09/2001	Dale F. McIntyre	83194F-P	5074
<div>7590 12/31/2007</div> <div>Milton S. Sales Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201</div> <div>EXAMINER WILLIAMS, JAMILA O</div> <div>ART UNIT PAPER NUMBER</div> <div>3722</div> <div>MAIL DATE DELIVERY MODE</div> <div>12/31/2007 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/973,031
Filing Date: October 09, 2001
Appellant(s): MCINTYRE ET AL.

**MAILED
DEC 31 2007
GROUP 3700**

Frank Pincelli
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10-1-2007 appealing from the Office action mailed 1-30-2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A prior decision by the Board of Patent Appeals and Interferences in the instant application was mailed May 30, 2006, Appeal No 2006-1498, Application 09/973,031.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,445,417	BROMER et al	8-1995
6,632,042	LIENER CHIN et al	10-2003
370,186	FOUNTAIN	9-1887
6,061,938	YOUNG	5-2000
3,848,348	HAWLEY	11-1974

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Bromer et al (5,445,417).

Bromer et al discloses in Fig. 1-7, an image product assembly comprising: a dual sided album leaf having a folded first ply layer (11a) and a second ply layer (11b), wherein each ply has an inner and an outer surface; wherein the ply layers are secured together (Col. 2, lines 60-65) to form a pocket (12) there between; wherein the first ply has a plurality of imaged indicia (ESKCO in Fig. 1, wherein each letter is considered an image; or 26 and 27 in Fig. 4); an insert

(17 or 28) having a size and configuration such that it can be placed with the pocket (see Fig. 3); wherein the insert has information (29) that relates to the plurality of imaged indicia and is located in a position (between image 26) such that it can be readily identified with respect to the images (26); and wherein the information of the insert is correlated with respect to its associated image by providing a size of the associated of the associated image (thickness of decorative image (26) surrounding the information (29)) at a reduced size having reduced visual characteristics (wherein the thickness of image (26) is sized smaller than the thickness of the information (letter) in order that an end user focus would be on the information (letters) rather than the images).

Claim 1, 4 and 12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Liener Chin et al (6,632,042).

Liener Chin et al discloses in Fig. 22 and 27, an image assembly comprising a leaf (850) having a folded first ply layer (864) and a second ply layer (868) having an outer surface and an inner surface (see Fig. 22); wherein the ply layers are secured together to form a pocket there between; wherein the outer surfaces of the ply layers have a plurality of imaged indicia (854 and 858); an insert (890) having a size configuration such that it can be placed within the pocket; and wherein the insert has information indicia (884) on both surfaces (Col. 11, lines 30-36) that relates to the plurality of imaged indicia (854, and 858) and is located in a position (as seen in Fig. 27)) such that it can be readily identified with respect to the imaged indicia (854 and 858).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Liener Chin et al (6,632,042).

Bromer et al disclose an image assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose wherein the outer surface of the first and second ply has a plurality of imaged indicia which correlate with the information indicia on a first and second surface of the insert.

Liener Chin et al discloses in Fig. 22, a dual sided album leaf comprising: wherein the outer surfaces of the a first ply layer (864) and a second ply layer (868) has a plurality of images (854, and 858) which correlate to the information (884 and 894) printed on a first and second surface of the insert (Col. 11, lines 34-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's album leaf with a images and information displayed on both sides of the album leaf as taught by Liener Chin et al for providing a means in which to display additional information.

Claims 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Fountain.

Bromer et al disclose an image assembly dual sided album leaf comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose wherein the insert is provided with a retaining member.

Fountain discloses in Fig. 1 and 2, an image assembly comprising wherein an insert (10) is provided with a retaining member or restraining tabs (11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's image assembly with an insert having a restraining means as taught by Fountain for preventing the insert from being completely pulled out from between the two plies.

Claim 7 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Young.

Bromer et al disclose a image assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose wherein the insert is folded such that when it is placed in the pocket, the insert is retained

Young discloses in Fig. 4, an assembly comprising a slidable foldable insert (32), wherein when the insert is placed in a pocket (as seen in Fig. 1-3), the insert is retained.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's image assembly with a slidable folded insert as taught by Young for the purpose of retaining the insert within the ply pocket.

Claims 8-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Hawley.

Bromer et al disclose a dual sided album leaf comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose: wherein the first and second ply layers are adhesively secured along three sides of the four sides, wherein the adhesive is placed on two surfaces of a spacer, which is then placed between the ply layers.

Hawley discloses an image assembly comprising a spacer (6) having adhesive on both of its surfaces and placed between two ply layers (4 and 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's assembly with an adhesively placed spacer as taught by Hawley for the purpose of connecting the plies and forming a pocket having space for an insert.

Claim 32 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al.

Bromer et al disclose a dual sided album leaf comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose: providing an outline copy of the associated image on the insert.

In regards to Claim 32, Bromer et al discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. The examiner asserts that the Bromer et al reference comprising an insert having image is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (printed image) and the substrate (insert) which is required for patentability. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

(10) Response to Argument

Regarding Appellant's argument towards the Bromer et al reference not providing a teaching for images on the front and back cover of the type to which the present invention is directed, the Examiner maintains that to the degree claimed by applicant, Bromer et al discloses a dual sided album leaf having a first and second ply secured together to form a pocket and the outer surface of the leaf having a plurality of graphics thereon which is being considered to form an image (see 16 of figure 1 or 26,27 of figure 4) and having an insert (17 or 28) with information thereon (18

or 29) that relates to the plurality of images and the information on the insert is located in a position on the insert such that it can be readily identified with respect to the plurality of images it is associated. It is noted that claim 1 only requires images on the first and/or second ply (the alternative condition is met by Bromer et al). Although Appellant argues that the information on the sheets of Bromer do not provide any information with regards to the images on the album leaf, the examiner maintains that letters in area 16 for example provide a company name or logo that is related to the information on the sheet 17 and this information on sheet 17 is positioned such that it can be readily identified with respect to the associated image 16. Additionally, in figure 3-4, images 26, 27 on the album leaf relates to the information 29 on insert sheet 28 in that it provides framing or highlighting or decorative affects to the information on the sheet and the information on the insert sheet 28 is positioned such that it can be readily identified with respect to images 26,27.

Similarly, regarding Appellant's argument towards Liner Chin et al not providing images on the on the album leaf as taught by applicant, the examiner maintains that Liner Chin et al provides a dual sided album leaf having a first and second ply secured together to form a pocket and the outer surface of both plies being provided with graphics or images (854,858) and an insert sheet having information on both surfaces (column 11 lines 30-36) that relates to the images on the leaf. Again this relationship can be considered a mere association between the two or as shown in figure 22 the images include indicia indicating an order of information (numbers 1-5, for example) and the information on the insert sheet is clearly located in a position such that it can be readily identified with respect to the imaged indicia. It is noted that the transparency of Liner

Chin et al is being argued by Appellant however this transparent feature does not prevent this reference from meeting the limitations of the pending claims.

The examiner maintains that to the degree claimed, Bromer et al and Liner Chin et al provide a relationship between the album leaf and insert as set forth above. Broadly speaking, having information that relates to the images can be interpreted to merely be associated with, which is met by the relationship of the images and information of both base references.

The rejections of the dependent claims with Fountain (applied for the insert with retaining member recited in claims 5-6), Young (applied for the foldable insert recited in claim 7) and Hawley (applied for the first and second ply layers being adhesively secured along three of the four sides, adhesive is placed on two surfaces of a spacer recited in claims 8-11) are also maintained. These references have not be relied upon for the limitations of claim 1.

Regarding Appellant's argument towards the use of Gullack in the rejection of claim 32, the examiner maintains that Bromer et al provides an insert with information or broadly speaking, a printed image, associated with the image of the album leaf, the sole difference is the content of the printed material. There is no novel or unobvious functional relationship between the printed matter (printed image) and the substrate (insert) which is required for patentability. Accordingly, there being no functional relationship of the printed material to the substrate, there is no reason to give patentable weight to the content of the printed matter, which by itself is non-statutory subject matter.

It is noted that the printed matter on the insert must be positioned such that it can be readily identified with respect to the images on the album leaf, and the examiner maintains that this relationship is met by Bromer et al. However the content of the indicia is what is the focus of the

Gullack rejection on the record and the examiner maintains that there is no novel or unobvious functional relationship between the printed matter (printed image) and the substrate (insert) which is required for patentability.

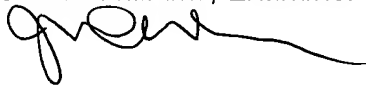
(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jamila Williams, Examiner



Conferees:


Monica Carter, SPE



Thomas Barrett, SPE

Attached are copies of Related Proceedings for the present application 09/973031 in the following order:

Appeal Brief (4-14-07)
Examiner's Answer (6-30-05)
Reply Brief (7-15-05)
Reply Brief Noted (9-30-05)
Board Decision (5-30-06)

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Docket 83194F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Christopher C. Cegelski, et al

ALBUM LEAF WITH INSERT

Serial No. 09/973,031

Filed October 09, 2001

Group Art Unit: 3722

Examiner: Mark T. Henderson

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U.S. PATENT AND TRADEMARK OFFICE
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AND INTERFERENCES

Sir:

APPEAL BRIEF TRANSMITTAL

In response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) dated March 7, 2005, resubmitted herewith, in triplicate, is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

Frank Pincelli

Attorney for Appellants
Registration No. 27,370

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Telephone: 585-588-2728
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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at

Docket 83194F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Christopher C. Cegelski, et al

ALBUM LEAF WITH INSERT

Serial No. 09/973,031

Filed 09 October 2001

Group Art Unit: 3722

Examiner: Mark T. Henderson

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APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of December 24, 2003 of claims 1, 3-12, 32 and 33 which was contained in the Office Action mailed February 24, 2004 and the Office Action dated

A timely Notice of Appeal was filed March 25, 2004.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1, 3-12, 32 and 33 have been rejected and are pending.

Claim 2 has been cancelled.

Claims 13-31 have been withdrawn.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

All amendments have been entered and the claims stand as indicated in Appendix I.

Summary Of The Invention

The present invention is directed to an image product assembly that includes a dual sided album leaf 12 having a first ply layer 14 and a second ply layer 16 each having an outer surface and an inner surface. The first and second ply layers 14, 16 form a pocket 23 for receiving an insert 24. The first and second ply layers 14, 16 have a plurality of images 30, 32, 44, 46, 48 formed thereon (see figures 2A and 2B). The insert 24 has a size and configuration such that it can be placed within the pocket 23, and has information 41, 43, 45, 47 and 49 as

illustrated in Figures 2A and 2B. The information relates to specific individual images of the plurality of images. The information on the insert is located in a position on said insert such that it can be readily identified with respect to which of the plurality of images it is associated with as illustrated by numerals 40, 42, 51, 53 and 55.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether the drawings fail to disclose structural detail that essential for a proper understanding of the invention under 37 CFR 1.83.
2. Whether claim 33 fails to meet the requirements of 35 USC § 112 for containing subject matter not described in the specification.
3. Whether claims 1, 3-6, 12, 32 and 33 are unpatentable under 35 USC § 103(a) over U.S. Patent 370,186 to Fountain.
4. Whether claim 7 is unpatentable under 35 USC § 103(a) as being unpatentable over U.S. Patent 370,186 to Fountain in view of Young (U.S. 6,061,938).
5. Whether claims 8-11 are unpatentable under 35 USC § 103(a) as being unpatentable over Fountain in view of U.S. Patent 3,848,348 to Hawley.

Grouping Of Claims

Group I:	Claims 1, 4, 5, 6, 8, 9, 10, 11, 12
Group II:	Claims 3, 32, 33
Group III:	Claim 7

Arguments

Objection to the drawings

In the Office dated August 25, 2004, objection to the drawings for failing "to show a ply layer not having any images thereon, however the images (30 and

32) are now printed on the insert alone as described in the specification (page 7, lines 15-17)". The Examiner argues that any structural detail that is essential for a proper understanding of the disclosed invention must be disclosed. Claim 1 specifically states "said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated." In this regard the embodiment illustrated in Fig. 2C described at the passage identified by the Examiner illustrated an embodiment where the information is provided over an image having a lower saturation (intensity). In this embodiment illustrated it is the lower intensity images that identifies which image the information is associated therewith provided on the claimed Album leaf. Applicant is not required to show every conceivable embodiment of the claimed invention, but simply at least one embodiment that supports the claimed invention. Applicants respectfully submit that drawings do indeed disclose appropriate structural detail of the claimed invention. There is no reason to show an insert without an image. The claimed invention requires that **"said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated"**. The drawings clearly provide such support.

The Rejection

Under 35 USC 112

The Examiner, in paragraph 3 of the Office Action dated August 25, 2004, rejected claim 33 under 35 USC § 112, as containing subject matter not described in the specification. In particular, the Examiner states "Claim 33, which is dependent on Claim 1, discloses wherein the insert further 'includes a low resolution or intensity image copy of the original image provided on the first or second ply layer'". The Examiner goes on to state that the specification at page 7, lines 15-17 argues that the specification does not support this. In this regard, Applicant refers the Examiner to page 11, lines 31 to page 12, line 1 where

Applicant refers to FIG. 2C and states that there is provided a low resolution or intensity image copy of the original image provided on the insert. This, in conjunction with the passages cited at page 7, clearly support the providing of the limitation as currently set forth in claim 33. Applicant respectfully submits the claims are adequately supported by the specification and meet all the requirements of 35 USC § 112.

Under 35 USC 103.

Group I: Claims 1, 4, 5, 6, 8, 9, 10, 11, 12

- A. The Examiner, in the Official Action dated December 24, 2003 rejected claims 1, 3-6, 12, 32 and 33 under 35 USC § 103 as being unpatentable over Fountain.

Claim 1 of the present invention is directed to a very specific product, in particular, it is directed to a dual sided album leaf having a first ply layer and a second ply layer each having an outer surface and an inner surface. The first and second ply layers are secured together so as to form a pocket there between. In addition, the outer surface of the first and/or second ply layer have a plurality of images formed thereon. Claim 1 further includes an insert having a size and configuration such that it can be placed within the pocket and has information thereon that relates to the plurality of images. In addition, the information on the insert is located in a position on the insert such that it can be readily identified with respect to which of the plurality of images it is associated. Applicants respectfully submit that the Fountain reference does not teach or suggest the invention as set forth by Applicants.

The Examiner, in the "Response to Argument" section of the Final Rejection dated 12/24/03 states that the Fountain reference is cited for disclosing an image placed on an insert wherein the insert further discloses information correlated to the image. The Examiner has further stated:

"[it] would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art."

The Examiner then cites *St. Regis Paper Co. v. Bemis Co.* for support that mere duplication of the essential working parts of a device involves only routine skill in the art and therefore it would have been obvious to include as many images as desired.

However, applicants respectfully submit that the Examiner has failed to appreciate the essential working parts of the present invention. The present invention is directed to providing a plurality of images on an album leaf with an insert providing information with respect to the image. The Fountain reference does not teach or suggest providing a plurality of images. Fountain discloses providing only a single image and providing biographical information with respect to the image. Furthermore, the information of the present invention that is provided on the insert is located such that the information can be readily identified with respect to which of the plurality of images it is associated. In the present invention, the fact that there are a plurality of images requires that the information provided can be readily related to its associated image. Since the Fountain reference does not disclose more than one image, Fountain could not address the problem to which the present invention is directed, that is, providing of information with respect to more than one image on an insert and associating that information so that it can be readily identified with respect to the image it is associated, therefore, providing the appropriate information with respect to its associated image.

The CAFC stated in *In Re Lee* 277 Fed 3rd 1330 (61 USPQ 2nd 1430) 2002 “the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record.” The court at 1443 stated “(our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references)”. The Court goes on to state “(there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant)”. The Court at 1443 stated “only by showing some objective teaching in the prior art or that knowledge generally

available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”.

In the present situation, the Fountain reference does not teach or suggest providing multiple images or associating specific information with each of the plurality of images. The Examiner merely relies on the fact that in the Examiner’s opinion it would be obvious to modify and provide as many images as desired. Even if one were to put more than one image as suggested by the Examiner, there is still no teaching or suggestion of providing information in a location such that it can be readily identified with respect to which of the plurality of images it is associated. Thus, the Examiner has failed to show:

- 1) motivation to modify or provide more than one image;
- 2) providing information for each image at a location such that the information can be readily identified with respect to which image it is associated.

The Examiner states correctly that when printed matter is not functional it will not distinguish the invention from the prior art in terms of patentability. In this regard, Applicants have clearly demonstrated the functionality of the information provided. The present invention does not simply claim printed matter, it claims that the printed matter is located at a position such that it can be readily identified with respect to which of the plurality of images it is associated. This is a functional relationship between the printed matter on the insert and the particular image it is associated therewith on the album leaf. The printed matter has a location on the insert that gives it functionality. The Examiner appears to argue that printed matter (such as size, dimension) is not the kind of functionality necessary for patentability. However, it is not mere size of the print to which the functionality of the printed matter in the present invention applies, it is the location of the various information on the insert and its relationship to the images that provides the functional relationship. Thus, it is respectfully submitted that claim 1 is patentable over Fountain. The remaining claims in this group depend at least ultimately upon independent claim 1 and are therefore also patentable for the same reason. The Hawley reference cited against claim 8 (which is dependent upon claim 1) does not teach or suggest anything that would render claim 1 unpatentable.

Group II: Claims 3, 32, 33

B. These claims have been rejected as being unpatentable over the Fountain reference. The claims in Group II set forth specific ways in which the information can be readily associated and identified with respect to which image is to be associated. As previously discussed, the Fountain reference does not teach or suggest more than one image and therefore could not face the problem of associating different types of information with different images to which the present invention is directed. Further, claim 3 includes the limitation that the information is correlated with the image by providing a smaller image of a reduced visual characteristic as shown. Claim 32 sets forth that an outline copy of the associated image is provided at a lower resolution (see Fig. 2C and specification at page 7, lines 10-24) for correlation of the information with the images. Applicants respectfully submit that the prior art fails to disclose any of the above limitation of these claims. Therefore, Fountain could not teach or suggest the invention as set forth by these claims.

Group III: Claim 7

C. The Examiner rejected claim 7 over Fountain. Group III contains only a single dependent claim, claim 7, which is dependent upon independent claim 1 and includes the additional limitation wherein the insert is folded for retaining of the insert within the pocket. Clearly the Fountain reference does not teach or suggest such a structure and therefore could not render obvious dependent claim 7. The Examiner has cited Young as disclosing a slidable foldable insert that when placed in a pocket allows it to be retained. However, it is not the folded insert that causes it to be retained, it is the shoulder-engaging extension 50 and the V-shaped insert 32 as shown in Figure 4 for limiting movement of the V-shaped insert toward the retracted position. See Column 4, lines 36-39. This is in contrast wherein it's the actual folded insert that results in it being retained and not some V-shaped limiting member.

Accordingly, it is respectfully submitted that Fountain in view of Young could not teach or suggest the invention as taught and claimed by Applicants.

Summary

In summary, Applicants respectfully submit that the claims in the present invention are patentably distinct over the cited prior art.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of the Claims.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Frank Pincelli', is written over a horizontal line.

Attorney for Appellants
Registration No. 27,370

Frank Pincelli/phw
Telephone: 585-588-2728
Facsimile: 585-477-4646
Enclosures

Appendix I - Claims on Appeal

1. An image product assembly, comprising:

a dual sided album leaf having a first ply layer and a second ply layer, said first and second ply layers each having an outer surface and an inner surface, said first and second ply layers are secured together so as to form a pocket there between, said outer surface of said first and/or second ply layer having a plurality of images formed thereon; and

an insert having a size and configuration such that it can be placed within said pocket, said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated.

3. An image product assembly according to claim 2, wherein said information is correlated with respect to its associated image by providing a size of said associated image at a reduced size having reduced visual characteristics.

4. An image product assembly according to claim 1, wherein said outer surface of said first and second ply each have a plurality of images and said insert having information with respect to said images on said first and second surfaces, said information being provided on said insert.

5. An image product assembly according to claim 1, wherein said insert is provided with a retaining member that prevents the insert from being pulled completely out of said pocket.

6. An image product assembly according to claim 5, wherein said retaining member comprises a pair of restraining tabs disposed at opposite ends of said insert, the restraining tabs being designed to be stopped by a retaining section in said leaf.

7. An image product assembly according to claim 1 wherein insert is folded such that when it is placed within said pocket it causes said insert to be retained within said pocket.

8. An image product assembly according to claim 1, wherein said first and second ply layers each comprise four sides and said first and second ply layers are secured together along three of said four sides.

9. An image product assembly according to claim 8, wherein an adhesive is used to secure said first and second ply layers together.

10. An image product assembly according to claim 8, wherein a generally u-shaped member is positioned along three of said four sides is provided for securing said first and second ply layers together.

11. An image product assembly according to claim 10, wherein an adhesive is applied to the inner surface of said first and second ply layers.

12. An image product assembly according to claim 1, wherein said first and second ply layers are formed by folding a single sheet.

32. (Original) An image product assembly according to claim 1 wherein said information is correlated with respect to associated image by providing an outline copy of set associated image on said insert.

33. (Original) An image product assembly according claim 1 wherein said insert includes a low resolution or intensity image copy of the original image provided on said first ply layer or second ply layer.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,031	10/09/2001	Dale F. McIntyre	83194F-P	5074

7590 06/30/2005

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/973,031
Filing Date: October 09, 2001
Appellant(s): MCINTYRE ET AL.

Frank Pincelli

For Appellant

EXAMINER'S ANSWER

MAILED

JUN 30 2005

Group 3700

This is in response to the appeal brief filed on April 14, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 4-6, and 8-12 (Group I), Claims 3, 32, 33 (Group II) and Claim 7 (Group III) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

370,186	G. W. FOUNTAIN	9-1887
6,061,938	YOUNG	5-2000
3,848,348	HAWLEY	11-1974

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 33 is rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior office action mailed on August 25, 2004.

Claims 1, 3-6, 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain. This rejection is set forth in prior office action mailed on August 25, 2004.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain in view of Young. This rejection is set forth in prior office action mailed on August 25, 2004.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fountain in view of Hawley. This rejection is set forth in prior office action mailed on August 25, 2004.

(11) Response to Argument

Appellant's arguments filed on April 14, 2005 have been fully considered but they are not persuasive.

In response to the objection to the drawings, the examiner has withdrawn the drawing objections and has approved the drawings.

In response to Claim 33, the examiner has withdrawn the 35 U.S.C. 112, First Paragraph Rejection, wherein Claim 33 now contains allowable subject matter.

In response to Issue 1 (Claims 1, 2-6, and 8-12), the appellant states that the Fountain reference does not teach or suggest providing a plurality of images on an

album leaf assembly. The examiner submits that Fountain discloses wherein the outer leaf of the first or second ply has at least one image or images (photo seen in Fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Furthermore, Fountain discloses in Col. 1, lines 10-12, "a means whereby a short biographical record may be preserved in connection with the photograph. Webster's Dictionary defines "biographical" as "relating to an account of the life of something. In its broadest sense, the "life of something" can either be a single person as shown in the figures, or it can be a group, an organization, a team, etc..., which contains a number of people (plurality of images) which form a single unison of an embodiment ("something"). Therefore, it would be obvious to modify the Fountain leaf to include as many images as desired by the end user to show additional displayed indicia (whether it is one photograph having a plurality of images (such as a sports team), or two separate photographic images (the Wright Brothers, who invented the first airplane).

In response to appellant's argument that the Fountain reference does not disclose wherein the information provided on the insert is located such that the information is readily identified with respect to the plurality of images it is associated and that the information has a reduced size of the associated image with reduced visual characteristics, the examiner submits that Fountain does indeed disclose an insert (10)

having a size and configuration so that it can be placed within the pocket, and wherein insert has information relating (gives account of the life of the image shown) to the image on the album leaf, and is located in a position such that it can be readily identified (the information can be identified when tab (12) is pulled upon by the end user) with respect to the associated image on the album leaf. Note, since appellant has not defined the metes and bounds of what is meant by "readily identified", the examiner has examined the claim in its broadest sense, that the information can be readily identified when the insert has been pulled out. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of imaged indicia or information indicia on the plies' outer surface and on the restrained insert, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter (information) is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content (a size provision and a second image) of the printed matter placed on the substrate (insert and ply) may render it more convenient by providing an individual with a specific type of form assembly does not alter the functional relationship. Mere support by the substrate (insert and plies) for the printed matter (images and information) is not the kind of functional relationship necessary for patentability. Thus, there is no novel or unobvious functional relationship between the printed matter and the substrate, which is required for patentability. Further, it would have been obvious to form the information in any

desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, the indicia information placed on the insert can be of any desirable size, since appellant has not disclosed the criticality of having a particular sized of indicia dimensions.

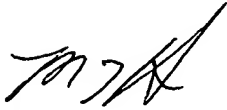
In response to appellant arguments that the prior art of Young does not disclose a folded insert retained in a pocket, the examiner submits that Young does indeed disclose a foldable insert (32) having "shoulder-engaging extensions" (50) to retain the insert in the pocket. Although the insert is not entirely retained in the pocket, portions of the insert are indeed retained as shown in Fig. 2.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/973,031
Art Unit: 3722

Page 8

Respectfully submitted,

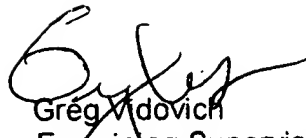


Mark Henderson
Examiner in Art unit 3722
June 27, 2005

Conferees



Derris Banks
Examining Supervisor
Art Unit 3722



Greg Vidovich
Examining Supervisor
Art Unit 3711

Milton S. Sales
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AR
Z/W

83194F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Christopher C. Cegelski, et al

ALBUM LEAF WITH INSERT

Serial No. 09/973,031
Filed 09 October 2001

Group Art Unit: 3722
Confirmation No. 5074
Examiner: Mark T. Henderson

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Paula West
Paula West

7-13-05
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Reply Brief

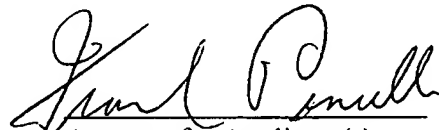
The Examiner, in the Answer mailed June 30, 2005, argues that it would have been obvious to modify Fountain to include a plurality of images taught and claimed by Applicant. However, the Fountain reference provides no teaching or suggestion of providing more than one image as taught and claimed by Applicant. Since there is only one image in Fountain, the information provided therewith would of course be associated with a particular image illustrated.

The problem to which the present invention is directed does not arise unless there is a plurality of different plurality of images and information associated with each image. In the present invention, the information is located such that it can be readily identified with respect to its associated image. Since Fountain only discloses a single image, it could not teach or suggest the problem to which the present invention is directed. The present invention is directed to different images and information associated with each of the separate images. The arguments that it would be obvious to provide more than one image is not

based on any teaching or suggestion in the prior art, and therefore is respectfully submitted is unsupportable. Further, even if more than one image was provided, there is no teaching or suggestion of solving the problem to which the present invention is directed. It is respectfully submitted that the claim language, when read in light of the specification, clearly supports the present invention which is not taught or suggested by the prior art.

Thus, for the above reasons and the reasons set forth in the Appeal Brief, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of the claims.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Frank Pincelli", written over a horizontal line.

Attorney for Applicant(s)
Registration No. 27,370

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Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,031	10/09/2001	Dale F. McIntyre	83194F-P	5074
7590 09/30/2005				
Milton S. Sales Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			EXAMINER	
			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 09/30/2005				

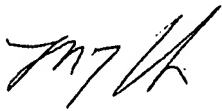
Please find below and/or attached an Office communication concerning this application or proceeding.

Examiner's Answer to Reply Brief

1. The reply brief filed on July 15, 2005 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for a decision on the appeal.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



Mark Henderson

Examiner/Art Unit 3722


BOYER D. ASHLEY
PRIMARY EXAMINER
Boyer Ashley

Supervisor/Art Unit 3722

September 24, 2005

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE F. MCINTYRE, CHRISTOPHER C. CEGELSKI
and JOHN K. MCBRIDE



Appeal No. 2006-1498
Application No. 09/973,031

ON BRIEF

Before FRANKFORT, OWENS, and BAHR, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1, 3-12, 32 and 33. Claim 2 has been canceled and claims 13-31 have been withdrawn from consideration by the examiner. Claim 33 is indicated in the examiner's answer as containing allowable subject matter (page 4).

THE INVENTION

The appellants claim an album leaf having an insert with information relating to a plurality of images on the album leaf. Claim 1 is illustrative:

Appeal No. 2006-1498
Application No. 09/973,031

1. An image product assembly, comprising:

a dual sided album leaf having a first ply layer and a second ply layer, said first and second ply layers each having an outer surface and an inner surface, said first and second ply layers are secured together so as to form a pocket there between, said outer surface of said first and/or second ply layer having a plurality of images formed thereon; and

an insert having a size and configuration such that it can be placed within said pocket, said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated.

THE REFERENCE

Fountain	370,186	Sep. 20, 1887
Hawley	3,848,348	Nov. 19, 1974
Young	6,061,938	May 16, 2000

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 3-6, 12 and 32 over Fountain, claim 7 over Fountain in view of Young, and claims 8-11 over Fountain in view of Hawley.¹

¹A rejection of claim 33 under 35 U.S.C. § 112, first paragraph, is withdrawn in the examiner's answer (page 4).

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Application No. 09/973,031

OPINION

We reverse the aforementioned rejections. We need to address only the sole independent claim, i.e., claim 1.²

Claim 1 requires an insert which has information thereon that relates to a plurality of images on an outer surface of a ply layer of a dual sided album leaf, and is located in a position on the insert such that it can be readily identified with respect to which of the plurality of images the information is associated.

Fountain discloses a biographical photograph card having, in its lower portion, a recess (20) within which a blank (10) fits (lines 41-43). A biographical record of a person whose photograph is shown in the upper part of the card is written on the forward face of the blank (lines 51-54). The blank normally is housed within a pocket in the lower portion of the card, and when it is desired to refer to the biographical record, the blank is pulled out of the pocket by use of a finger tab (12) (lines 56-59).

²The examiner does not rely upon Young or Hawley for any disclosure that remedies the deficiency in Fountain as to the independent claim.

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Application No. 09/973,031

The examiner argues that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images [on Fountain's card] as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art" (answer, page 5). The examiner is relying on a per se rule of obviousness. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on per se rules of obviousness is legally incorrect and must cease." For a prima facie case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The examiner has not explained how Fountain itself would have fairly suggested a plurality of images to one of ordinary skill in the art.

The examiner argues that "biographical" relates to an account of the life of something, and that because "life of something" can pertain to either a single person or a group, Fountain would have fairly suggested, to one of ordinary skill in the art, displaying separate images of the members of a group (answer, page 5). Even if one of ordinary skill in the art had

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Application No. 09/973,031

considered "life of something" to possibly pertain to a group, the examiner has not established that Fountain would have fairly suggested, to such a person, showing the members of the group in separate images. The record indicates that the examiner's motivation for using separate images comes from the appellants' disclosure rather than coming from the applied reference and that, therefore, the examiner used impermissible hindsight in rejecting the appellants' claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

The examiner argues that there is no functional relationship between the appellants' printed matter and the substrate (answer, p. 6). The functional relationship is that the printed matter must be located in a position on the insert such that it can be readily identified with respect to which of a plurality of images on the outer surface of a ply layer the information is associated.

For the above reasons we conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellants' claimed invention.

Application No. 09/973,031

DECISION


The rejections under 35 U.S.C. § 103 of claims 1, 3-6, 12 and 32 over Fountain, claim 7 over Fountain in view of Young, and claims 8-11 over Fountain in view of Hawley, are reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

BOARD OF PATENT
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AND
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JENNIFER D. BAHR
Administrative Patent Judge

Appeal No. 2006-1498
Application No. 09/973,031

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TJO/jrg